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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,966	10/24/2003	Khader S. Abdel-Hafez	3359-Z	6973

7590 02/16/2006

Law Office of Jim Zegeer
Suite 108
801 North Pitt Street
Alexandria, VA 22314

EXAMINER

TRIMMINGS, JOHN P

ART UNIT	PAPER NUMBER
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2138

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,966

Applicant(s)

ABDEL-HAFEZ ET AL.

Examiner

John P. Trimmings

Art Unit

2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This office action is in response to the applicant's amendment dated 12/12/2005.

Claims 83-106 are pending.

CIP Priority Not Granted

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is not granted. The applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 or 120 as follows:

This application is claiming the benefit of prior-filed nonprovisional application No. 10/067,372 under 35 U.S.C. 120, 121, or 365(c). However, Rules, 37CFR 1.63e requires a newly executed oath ("A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application"). The applicant has not complied with said CFR 163e, therefore, the examiner will not enter the amendment to the Specification submitted by the applicant dated 12/12/2005, in which the applicant claims that the instant application is a CIP of 10/067,372.

2. Additionally, in regard to the applicant's claim for the benefit of the prior-filed application 10/067,372 under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c), priority is also not granted because the benefit of an earlier filing date under 35 U.S.C. 119 or 120 has not been met as follows: As per 37 CFR 1.78 I.B., "Only the claims of

the continuation-in-part application that are disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application are entitled to the benefit of the filing date of the prior-filed application. If there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date". The disclosure of the prior-filed nonprovisional application, Application No. 10/067,372, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The applicant's prior-filed nonprovisional application fails to teach a global set/reset signal as is claimed in the two independent claims of the subject application. Since there is no teaching of the said signal, the examiner has determined that the priority based on the prior nonprovisional application is not granted.

Response to Amendment

3. As per the applicant's argument re:Wang:

Applicant's arguments filed 12/12/2005 have been fully considered but they are not persuasive. The applicant argued that the application is entitled to the filing date of Wang, (10/067,372) and thus ORCA is rendered moot. But the benefit of the filing date of Wang has not been granted (see sections 1 and 2 above), and so the reference ORCA is maintained.

4. As per the applicant's argument re: Provisional Application 60/422,117:

Applicant's arguments filed 12/12/2005 in regard to the benefit of priority of the provisional application have been fully considered but they are not persuasive. The later-filed application must be an application for a patent for an invention that is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed provisional application, Application No. 60/422,117, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The applicant's argument that the prior-filed application "implies" global set/reset and scan-enable is not sufficient to teach global set/reset and scan-enable as is claimed in the two independent claims of the subject application. Since there is no teaching of the signals, the examiner maintains the finding in the previous office action dated 9/13/2005, that domestic priority based on the prior provisional application is not granted.

5. As per Rejections under 35 USC 103:

In view of the above, and since the applicant has not argued the merits of Ahanin, the AAPA, Wang and ORCA, the examiner maintains the rejections of Claims

83-106 under 35 USC 103 of said claims as outlined in the previous office action dated 9/13/2005.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Trimmings whose telephone number is (571) 272-3830. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Trimmings
Examiner
Art Unit 2138

jpt



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